



11-08-04

EV486128625US

1fw

November 5, 2004

CERTIFICATE OF MAILING

I hereby certify that this paper (along with any paper referred to as being is being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage for Express Mail EV 38301504 US in an envelope addressed to: Mail Stop: Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450:


Jennifer Hopper

November 5, 2004
Date of Deposit

Mail Stop: Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Re: **Brake Disks And Methods For Coating**
Serial No. 10/691,120
Our Reference No.: 8041-022-US

Dear Sir or Madam:

In response to the Office Action of the above-referenced Non Provisional Application, mailed on October 8, 2004 enclosed please find the following:

1. Transmittal Form PTO/SB/21 (1 page);
2. Response To Restriction Requirement (3 pages);
3. Copy of Office Action Summary (5 pages); and
4. Self-addressed, stamped postcard.

The self-addressed, stamped postcard has been included for your convenience. After confirming receipt of these documents please return the postcard to us at your earliest convenience. Should you have any questions, please do not hesitate to contact me by phone at (858) 450-0099.

Sincerely yours,



Laura Pereira, Esq.
Reg. No. 55,534
Attorney for the Applicant

Enclosures



PTO/SB/21 (09-04)
Approved for use through 07/31/2006. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	10/691,120
	Filing Date	October 22, 2003
	First Named Inventor	Nathan K. Meckel
	Art Unit	3683
	Examiner Name	Sy, Mariano Ong
Total Number of Pages in This Submission	Attorney Docket Number	8041-022-US

ENCLOSURES (Check all that apply)		
<input type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> After Allowance Communication to TC
<input type="checkbox"/> Fee Attached	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input checked="" type="checkbox"/> Amendment/Reply	<input type="checkbox"/> Petition	<input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> After Final	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address	<input type="checkbox"/> Status Letter
<input type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Terminal Disclaimer	<input type="checkbox"/> Other Enclosure(s) (please identify below):
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Request for Refund	
<input type="checkbox"/> Information Disclosure Statement	<input type="checkbox"/> CD, Number of CD(s) _____	
<input type="checkbox"/> Certified Copy of Priority Document(s)	<input type="checkbox"/> Landscape Table on CD	
<input type="checkbox"/> Reply to Missing Parts/Incomplete Application	Remarks	
<input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53		
SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT		
Firm Name	Catalyst Law Group. APC	
Signature		
Printed name	Laura Pereira. Esq.	
Date	November 5, 2004	Reg. No. 55,534

CERTIFICATE OF TRANSMISSION/MAILING		
I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:		
Signature		
Typed or printed name	Jennifer Hopper	Date November 5, 2004

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Nathan K. Meckel	Examiner:	Sy, Mariano Ong
Serial No.:	10/691,120	Art Unit:	3683
Filed:	October 22, 2003	Attorney Ref. No.:	8041-022-US
Title: BRAKE DISKS AND METHODS FOR COATING			

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

Dear Commissioner:

In response to the Restriction Requirement of October 8, 2004, Applicant responds as follows:

I. **THE RESTRICTION REQUIREMENT**

Restriction of the following inventions was required under 35 U.S.C. § 121:

Group I is claims 1-8 and 17-20, drawn to a coated brake disk, classified in class 188, subclass 218XL.

Group II is claims 9-16, drawn to a method for manufacturing a coated brake disk, classified in class 427, subclass 580.

As stated by the Examiner, the “[i]nventions of Group I and Group II are related as process of making and product made.” The inventions of groups I and II were stated to be distinct from each other because “a) the product as claimed can be made of a materially different method such as plasma spraying or electroless plating or chemical vapor deposition; b) the method as claimed can be used to make a materially different product such as clutch disk, flywheel or pressure plate.”

II APPLICANT’S RESPONSE

Applicant elects the invention of Group I, claims 1-8 and 17-20, drawn to a coated brake disk, for prosecution on the merits, with traverse.

The Restriction Requirement is respectfully traversed on the following grounds:

The Examiner has not met the burden for demonstrating the necessity for restriction. M.P.E.P. § 803 requires for restriction both: (1) that the inventions are independent or distinct as claimed; and (2) that there would exist a “serious burden” on the Examiner if all of the claims were examined in one application.

These requirements have not been met. Firstly, there is no demonstration that a “serious burden” on the Examiner would exist.

The subject matter of the inventions is sufficiently interrelated that no serious burden on the Examiner would exist if all of the claims were examined on the merits. This is because the art involved, if any relevant art exists, largely overlaps. For example, publications describing the method for manufacturing a coated brake disk will invariably report on coated brake disks. Thus, there is not basis for restricting the claims based on the distinction between the inventions of groups I and II. Accordingly, the inventions of Groups I and II, which are a product and the process of making that product, should be examined together.

Applicant does not traverse the restriction on the basis of a lack of patentable distinctiveness. Rather, Applicant traverses the Restriction Requirement on

the relatedness of the subject matter comprising Groups I and II. Applicant, who is presenting this information in a unitary manner in one patent application, should not be penalized by restriction when the subject matter is so clearly related. More significantly, the art required to search these groups is so closely related that there does not exist a "serious burden" on the Examiner if searched and examined in a single application. The determination of the existence or non-existence of a "serious burden" should not be made according to arbitrary principles, but should reflect the actual state of the art.

Accordingly, the Restriction Requirement is respectfully traversed. The Examiner is therefore respectfully requested to withdraw the Restriction Requirement and examine all of the claims on the merits.

III. CONCLUSION


In conclusion, Applicant elects the invention of Group I, claims 1-8 and 17-20, drawn to a coated brake disk, for prosecution on the merits, with traverse.

The Restriction Requirement is respectfully traversed, and Applicant requests that the Restriction Requirement be withdrawn.

Respectfully Submitted,

Date: Nov. 5, 2004

CATALYST LAW GROUP, APC
4220 La Jolla Village Drive, Suite 220
San Diego, California 92122
(858) 450-0099
(858) 450-9834 (Fax)


Laura E. Pereira, Esq., Reg. No. 55,534
Attorney for Applicant